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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/346,063

07/01/1999

KENT J. SIEFFERT

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05/12/2009

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EXAMINER

NGUYEN, NGA B

ART UNIT

PAPER NUMBER

3692

MAIL DATE

DELIVERY MODE

05/12/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/346,063	Applicant(s) SIEFFERT ET AL.	
	Examiner Nga B. Nguyen	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5 and 10-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 28, 2009 has been entered.
2. Claims 5 and 10-14 are pending in this application.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 5 and 10-14 have been fully considered but are moot in view of new grounds of rejection.

In response to the applicant's arguments that Kossovsky does not disclose "*permitting the network user to select one or more of the terms of said interest*", examiner totally disagrees. Examiner submits that Kossovsky discloses in figures 5B, 5C and 7A that the network user permits to select one or more of the terms of said interest (*e.g. Patent citations, Non Patent citations, Art, Sound, and Video Files, Asking Price, Royalty Rate, Currency, License Terms, Auction Expiration Date, etc.*). Also, see figures 10-11 of applicant's disclosure for the equivalent to figures 5B, 5C and 7A of Kossovsky. Therefore, Kossovsky does disclose "*permitting the network user to select one or more of the terms of said interest.*"

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 5 and 10-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 5 and 10-14 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a

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particular machine. Thus, claims 5 and 10-14 are non-statutory since they may be performed within the human mind.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.

Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 5 and 10-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Kossovsky et al (hereinafter Kossovsky), U.S. Patent Application Publication No. 2002/0004775.

Regarding to claim 5, Kossovsky discloses a method for facilitating transfer of an interest in an intellectual property asset via global computer network, the method comprising:

formulating a proposed transfer of an interest in an intellectual property asset based on input submitted by a network user (*paragraphs 0043-0044, seller submits data describing the IP listed on the exchange*);

presenting one or more terms of said interest for the proposed transfer
(paragraphs 0043-0044, seller submits data describing the IP listed on the exchange and figures 5A-5C);

permitting the network user to select one or more of the terms of said interest
(paragraphs 0043-0044, seller submits data describing the IP listed on the exchange and figures 5A-5C);

limiting bidders via an access profile *(paragraph 0064 and 0153);*

defining the proposed transfer based at least part on the terms selected by the user *(paragraphs 0043-0044, seller submits data describing the IP listed on the exchange and figures 5A-5C);* and

posting the proposed transfer on a network resource residing on the global computer network *(paragraphs 0043-0044, seller submits data describing the IP listed on the exchange).*

Regarding to claim 10, Kossovsky discloses a method for facilitating transfer of interests in intellectual property assets via a global computer network, the method comprising:

auctioning an interest in an intellectual property asset via a network resource residing on the global computer network, wherein auctioning an interest includes listing, as part of an auction process, an asset identifier corresponding to the asset and terms of transfer of the interest in the intellectual property asset *(paragraphs 0043-0044, seller submits data describing the IP listed on the exchange);*

limiting access to the asset identifier and the terms of transfer as a function of an access profile associated with each network user (*paragraphs 0064 and 0153*);

permitting the network user to select one or more of the terms of said interest (*paragraphs 0043-0044, seller submits data describing the IP listed on the exchange and figures 5A-5C*);

gathering bids from network users (*paragraph 0172, the participants submit bids to the exchange*); and

automatically adjusting the terms of transfer in the event no sufficient bids are gathered within a predetermined period of time (*paragraph 0173, e.g., the exchange auction master can start at a low bid, increase bid until the number of buyers willing to buy his merchandise matches his inventory*).

Regarding to claim 11, Kossovsky discloses wherein limiting bidders via an access profile includes accessing a database of access profiles, wherein each network user has an associated access profile (*paragraph 0153*).

Regarding to claim 12, Kossovsky discloses a method for auctioning an interest in an intellectual property asset via a global computer network, the method comprising:

offering the interest in the intellectual property asset via a network resource residing on the global computer network, wherein the interest in the intellectual property asset is defined by a proposed transfer agreement and a profile of users granted access to the proposed transfer agreement (*paragraphs 0043-0044, seller submits data describing the IP listed on the exchange; paragraphs 0064 and 0153*);

permitting the network user to select one or more of the terms of said interest (*paragraphs 0043-0044, seller submits data describing the IP listed on the exchange and figures 5A-5C*);

collecting bids from network users meeting the profile of users granted access to the proposed transfer agreement (*paragraph 0172, the participants submit bids to the exchange*); and

accepting one of said bids (*paragraphs 0050-0051, seller accept bid*).

Regarding to claim 13, Kossovsky discloses wherein the proposed transfer agreement is a proposed licensing agreement (*paragraph 0009*).

Regarding to claim 14, Kossovsky discloses wherein the in intellectual property asset is a patent (*paragraph 0009*).

Conclusion

8. Claims **5 and 10-14** are rejected.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communication intended for entry),

or

(571) 273-6796 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Nga B. Nguyen/

Primary Examiner, Art Unit 3692

May 5, 2009